

REMARKS

I. Restriction Requirement

The Examiner requires restriction between the following groups of claims:

Group I - Claims 47-84, drawn to a composition comprising a physiologically acceptable medium comprising a fatty phase, the fatty phase comprising at least one ester resulting from the reaction of a polyol with a carboxylic acid; and

Group II - Claim 85, drawn to a method for preparing a cosmetic composition comprising a physiologically acceptable medium comprising a fatty phase, the fatty phase comprising at least one ester resulting from the reaction of a polyol with a carboxylic acid.

Applicants respectfully traverse the restriction requirement, as set forth above and on page 2 of the Office Action. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising claims 47-84, drawn to a composition comprising a physiologically acceptable medium comprising a fatty phase, the fatty phase comprising at least one ester resulting from the reaction of polyol with a carboxylic acid.

The instant application is a national stage filing under 35 U.S.C. § 371 and thus unity of invention practice applies to the application. The Examiner contends that "Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of a composition comprising a reaction product from a polyol and a carboxylic acid is already known in the art. See Corcoran et al. (US 5368857) ... Corcoran teaches a composition which

comprises a neoalkanol ester such as isostearyl neopentanoate. Isostearyl neopentanoate meets the instant claims limitations for the resultant reaction product. Thus, because the instantly claimed subject matter has already been suggested, the Groups of inventions lack unity." Office Action at 2.

Applicant respectfully traverses the restriction on the basis that all of the present claims share the common technical relationship of a composition comprising the elements set forth in claim 47. See M.P.E.P. § 1893.03. The claims in Group I are drawn to a composition comprising the elements set forth in claim 47, the claims in Group II are drawn to a method for preparing a cosmetic composition comprising the elements set forth in claim 47. Accordingly, Groups I-II should be rejoined.

Furthermore, the Office alleges that the ester recited in Applicant's claim 47 (i.e., an ester resulting from a polyol and a carboxylic acid) has been "suggested" by Corcoran. Office Action at page 2. Applicant respectfully disagrees and reserves any further response until the issuance of an official action directed towards Corcoran and the elected subject matter.

Applicants submit that the Examiner's restriction requirement is improper and should be withdrawn.

II. Election of Species

The Examiner also requires the following election of species;

- A) an ester compound resulting from the reaction of a polyol and a carboxylic acid (see Example formulations); and

B) a form of the composition (i.e. anhydrous or emulsion; see instant claims 83 and 84).

See Office Action at 4.

The election of species requirement is respectfully traversed. However, to be fully responsive, Applicant provisionally elects, with traverse:

- A) Regarding the claimed ester compound, Applicant elects neopentyl glycol dineopentanoate, with claims 47-63, 66, 69-85 reading on the elected species either literally or under the doctrine of equivalents.
- B) Regarding the form of the composition, Applicant elects an anhydrous composition, with claims 47-83, and 85 reading on the elected species either literally or under the doctrine of equivalents.

As with the restriction requirement discussed above, the Examiner merely asserts that "these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1." The Office acknowledges that claims 47 and 85 are generic. See Office Action at 5. If the election of species requirement is maintained, Applicant expects the Office, upon allowance of the elected species, to continue to examine the full scope of the subject matter presently claimed to the extent necessary to determine the patentability thereof, as required by 35 U.S.C. § 121 and M.P.E.P. § 803.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and examination of the claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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